

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

Remarks/Arguments

This paper is being filed in response to the Official Action of the Examiner mailed September 16, 2003, setting a three-month shortened statutory period for response ending December 16, 2003. Claims 1-2, 4-6 and 9-31 remain pending. Claims 3 and 7-8 have been canceled without prejudice, and claims 23-31 have been added. Reconsideration, examination and allowance of all pending claims are respectfully requested.

As a preliminary matter, Applicant submitted a supplemental IDS on August 15, 2003.

Applicant respectfully requests that the Examiner consider the references cited in the August 15, 2003 IDS, and provide an initialed copy of the FORM-1449 filed therewith in due course.

In paragraph 1 of the Office Action, the Examiner objected to the title as being not sufficiently descriptive. In response, the title has been amended to be more descriptive.

In paragraph 2 of the Office Action, the Examiner objected to the abstract because it includes phrases which can be implied. In response, the abstract has been amended to overcome the Examiner's objections.

In paragraph 3 of the Office Action, the Examiner rejected claims 1-18 and 11-20 under 35 U.S.C. § 102(b) as being anticipated by Nagano (U.S. Patent No. 5,430,627). In response, claim 1 has been amended to recite:

1. (Currently Amended) A lighting apparatus for receiving an elongated light source, comprising:
an elongated member ~~having a height, a thickness and a length, the height being substantially greater than the thickness, the elongated member having a first material and a second material and an outer surface, the first material being at least partially transparent and the second material being at least substantially non-~~

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

transparent, the elongated member further having a cavity extending along at least part of the length of the elongated member for receiving the elongated light source, the cavity being at least partially defined by a the first material that is at least partially transparent and which extends to an two or more portions of the outer surface of the elongated member, the two or more portions of the outer surface being separated from one another by a separating portion of the outer surface that includes the second material that is at least substantially non-transparent.

As can be seen, claim 1 recites an elongated member that includes a cavity for receiving a light source, wherein the cavity is at least partially defined by a first material that is at least partially transparent and which extends to two or more portions of the outer surface of the elongated member. Claim 1 also recites that the two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second material that is at least substantially non-transparent.

In contrast to claim 1, Nagano provides a light fixture housing that includes a first and a second channel, each for mounting a different string light fixture beneath a corresponding removable translucent cover (see Nagano: Abstract; Figure 7, column 4, line 41 through column 8, line 15). As can be seen, Nagano clearly suggests providing two independent channels 129 and 135, each for receiving a light fixture, and each for receiving a removable translucent cover. Thus, neither of the “channels” 129 or 135 of Nagano is at least partially defined by a first material that is at least partially transparent and which extends to two or more portions of the outer surface of the elongated member, wherein the two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

material that is at least substantially non-transparent. In fact, it would appear that Nagano actually teaches away from the invention recited in claim 1. For these reasons as well as other reasons, claim 1 is believed to be clearly patentable over Nagano. For similar and other reasons, dependent claims 2, 4-6, 9-10 and 24-28 are also believed to be clearly patentable over Nagano.

Turning now to claim 11. Claim 11 has been amended to recite:

11. (Currently Amended) A lighting apparatus for receiving an elongated light source, comprising:
a monolithic an elongated member including a first material that is at least partially transparent a second material that is at least substantially non-transparent, the monolithic elongated member having a height and a cavity with a maximum lateral dimension, the cavity extending that extends along the length of the elongated member for receiving the elongated light source, the cavity and being at least partially defined by a the first material that is at least partially transparent and which extends to an outer surface of the housing.

Claim 11 recites a monolithic elongated member that includes a first material that is at least partially transparent a second material that is at least substantially non-transparent. Claim 11 also recites that the monolithic elongated member has a cavity that extends along the length of the elongated member for receiving the elongated light source, wherein the cavity is at least partially defined by the first material that is at least partially transparent and which extends to an outer surface of the housing. In contrast, and as indicated above, Nagano appears to teach to provide “removable translucent covers” (see Nagano, Abstract, line 4). The “removable” nature of the translucent covers appears to be necessary to initially install, and then subsequently maintain, the string light fixtures secured within the channels. As such, there would appear to be no motivation whatsoever to make the light fixture housing and the removable translucent covers

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

of Nagano monolithic. For these and other reasons, claim 11 is believed to be clearly patentable over Nagano. For similar and other reasons, newly presented dependent claim 31 is also believed to be clearly patentable over Nagano.

Turning now to claim 12. Claim 12 has been amended to recite:

12. (Currently Amended) A lighting apparatus adapted for use with a stair or other ledge, comprising:
~~an elongated light source;~~
an elongated member having a cavity with a length for receiving the
~~elongated light source~~, the cavity being at least partially defined by a first material that is at least partially transparent which extends from the cavity to a first outer surface of the elongated member; and
an elongated light source extending along at least a major length of the cavity, the elongated light source providing a relatively uniform light output along at least a major length of the elongated light source.

As can be seen, claim 12 recites a lighting apparatus adapted for use with a stair or other ledge that includes an elongated member with a cavity. Claim 12 further recites an elongated light source that extends along at least a major length of the cavity, wherein the elongated light source provides a relatively uniform light output along at least a major length of the elongated light source. In contrast to claim 12, Nagano suggests using a string of light bulbs. More specifically, Nagano states:

The preferred lighting fixture 61 is that disclosed in U.S. Pat. No. 5,045,981, incorporated by reference herein and shown in more detail in FIG. 9. Briefly, this light fixture employs a light bulb 62 inserted in a socket which is releasably secured to a carriage 63. The electrical contact to a pair of leads on the light bulb 62 is made by a pair of arcuate terminals fastened within the carriage 63. The terminals have one free end so that they may bend freely upon insertion of the socket within the carriage. The socket includes a depression configured to conform to the shape of the arcuate terminals, so that the terminals snap into the depression when the socket is inserted into the carriage 63. The leads extend

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

across the depression to improve the electrical contact. The socket is further secured to the carriage 63 by a pair of grooves which mate to the carriage's guiding rails.

According to the preferred embodiment, the lamp carriage 63 is attached to the base 171 of a metal wedge clip carriage 173, e.g., by gluing. The wedge clip carriage 172 includes two wings 172, 174 attached to the respective edges of the base and extending outwardly therefrom. The wings 172, 174 are springably attached to the base such that they may bend in an arc 176 about the position shown in FIG. 10a.

FIGS. 10a-10d illustrate how the wedge clip carriage 173 is inserted into and retained by a cooperating channel such as 129. In FIG. 10a, the wedge clip carriage 173 is about to be inserted into the channel 129. In FIG. 10b, the wedge clip carriage 173 is initially being inserted into the channel 129, and the wings 172, 174 are being slightly forced inward against their bias towards the light fixture 61. In FIG. 10c, the wedge clip carriage 173 is almost completely inserted into the channel 129, and the wings 172, 174 have been forced inward by tangs 131, 133 located on a pair of relatively rigid interior channel walls 132, 134. FIG. 10d illustrates the wedge clip lamp carriage 173 completely inserted, in which position the wings 172, 174 have released outwardly against the walls 132, 134 and beneath the tangs 131, 133.

With respect to channel 129, it will be observed, for example, from FIG. 10e, that the tangs 131, 133 are raised above the base of the channel 129 to a height sufficient such that the base 171 of the wedge clip carriages 173 will not bottom out as the spring clip sides or wings 172, 174 are pinched in by the tangs 131, 133, thereby permitting the carriages 173 to be snapped into the channel 129.

(Nagano, column 3, line 61 through column 4, line 40). As can be seen, Nagano suggests using a number of point light source (i.e. light bulbs). In addition, much of the structure of Nagano is provided to accommodate the series of point light sources (see, for example, Figures 9, 10a-10d and 13 of Nagano). Therefore, Applicant does not believe it can readily be argued that it would have been obvious to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano's disclosure, with an elongated light source that provides a relatively uniform light output along at least a major length of the

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

elongated light source, as recited in claim 12. Applicant would like to point out that although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (see, MPEP §2143.01). In the present case, there is no suggestion or motivation whatsoever in Nagano to replace the point light sources of Nagano, including all of the supporting structure which appears to be a main thrust of Nagano’s disclosure, with an elongated light source that provides a relatively uniform light output along at least a major length thereof, as recited in claim 12. For these and other reasons, claim 12 is believed to be clearly patentable over Nagano. For similar and other reasons, dependent claims 13-23 are also believed to be clearly patentable over Nagano.

In paragraph 4 of the Office Action, the Examiner rejected claims 9, 10, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Nagano (U.S. Patent No. 5,430,627). For the reasons discussed above, as well as other reasons, Applicant believes that dependent claims 9, 10, 21 and 22 are clearly patentable over Nagano.

Newly presented claim 29 recites:

29. (New) A method for forming a lighting apparatus that is adapted to receive a light source, the method comprising the steps of:

coextruding a first material and a second material to form an elongated member having an outer surface and a cavity for receiving the light source, the first material being at least partially transparent and the second material being at least substantially non-transparent, the first material forming a light guide from the cavity to two or more portions of the outer surface of the elongated member, wherein the two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second material that is at least substantially non-transparent.

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

As can be seen, newly presented claim 29 recites a method for forming a lighting apparatus that is adapted to receive a light source. Claim 29 further recites coextruding a first material and a second material to form an elongated member having an outer surface and a cavity for receiving the light source, wherein the first material is at least partially transparent and the second material being at least substantially non-transparent. Claim 29 also recites that the first material forms a light guide from the cavity to two or more portions of the outer surface of the elongated member, wherein the two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second material that is at least substantially non-transparent.

Nothing in Nagano suggest coextruding a first material and a second material to form an elongated member having an outer surface and a cavity for receiving the light source, wherein the first material is at least partially transparent and the second material being at least substantially non-transparent. Instead, and as noted above, Nagano suggests separately forming the light fixture housing and the removable translucent covers. As noted above, the “removable” nature of the translucent covers of Nagano appears to be necessary to initially install, and then subsequently maintain, the string of lights within the channels. As such, there would appear to be no motivation whatsoever to coextrude a first material and a second material to form an elongated member having an outer surface and a cavity for receiving the light source, wherein the first material is at least partially transparent and the second material being at least substantially

Application No. 10/074,364
Amendment dated December 15, 2003
Reply to Office Action dated September 16, 2003

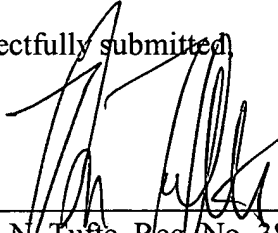
non-transparent, as recited in claim 29. In fact, it would appear that Nagano actually teaches away from such a method.

In addition, and as noted above with respect to claim 1, Nagano does not suggest forming a light guide from the cavity to two or more portions of the outer surface of the elongated member, wherein the two or more portions of the outer surface are separated from one another by a separating portion of the outer surface that includes the second material that is at least substantially non-transparent. Thus, for these and other reasons, newly presented claim 29 is believed to be clearly patentable over Nagano. For similar and other reasons, newly presented dependent claim 30 is also believed to be clearly patentable over Nagano.

In view of the foregoing, Applicant believes that all pending claims 1-2, 4-6 and 9-31 are now in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner believes it would be beneficial to discuss the application or its examination in any way, please call the Applicant at (612) 573-2002.

Respectfully submitted,

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